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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,225	12/08/2003	John DeNatale JR.		4628

7590 10/01/2004  
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EXAMINER

NOVOSAD, JENNIFER ELEANORE

ART UNIT PAPER NUMBER

3634

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/730,225

**Applicant(s)**

DENATALE, JOHN

**Examiner**

Jennifer E. Novosad

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the panels and slots recited in claim 12 must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 recites that the first compartments have a "depth of approximately 3 ¾ inches" and the second compartments have a "depth of approximately 4 ½ inches" while the original specification states that "Each of the compartments are of a width specially designed to securely hold VCR tapes or DVD's" (see page 14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,031,779 (Szenay *et al.* '779) in view of U.S. Patent No. 5,685,423 (Hunt '423).

Szenay *et al.* '779 disclose a rotating display holder for media which comprises a generally housing (see Figure 1) with a flat bottom and a flat top (20) so that other holders can be stacked thereon (see Figure 4); the housing having first compartments on one side (right side of Figure 2) and second compartments on another side (left side of Figure 2). *With respect to claim 12*, note the drawing objection above.

The claims differ from Szenay *et al.* '779 in requiring: (a) the first compartments to have a width of approximately 1 ¼ inches to hold VCR tapes and the second compartments to have a width of approximately ¾ of an for holding DVD's (claim 7); (b) the first compartments to have a depth of approximately 3 ¾ inches and the second compartments to have a depth of approximately 4 ½ inches (claim 7); (c) the holder to be made from wood (claim 4); and (d) the holder to be made from metal (claim 11).

*With respect to (a)*, Hunt '423 teaches that it is old to have a holder which comprises different sized compartments for storing and holding different sized media therein wherein some of the compartments are first compartments and the width thereof is 1 inch (see column 1, lines 44), i.e., 1 inch is considered to be *approximately* 1 ¼ inches, for holding video tapes case, i.e.,

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VCR tapes; and some of the compartments are second compartments and the width thereof is 0.41 inches (see column 1, line 51), i.e., 0.41 inches is considered to be *approximately*  $\frac{3}{4}$  inch, for holding video games and compact disc cases.

*Thus*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the holder of Szenay *et al.* '779 with different sized compartments for ease in use to the consumer since the holder can be used in different environments and for different uses.

*With respect to (b)*, although Szenay *et al.* '779 do not disclose the compartments having the specified depth dimensions, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have fabricated the compartments having a depth of approximately 4 inches, i.e., a compartment having a depth of 4 inches is considered to be *approximately*  $3\frac{3}{4}$  inches and *approximately*  $4\frac{1}{2}$  inches (as required in claim 7), thereby allowing for ease in use since objects having different depths can be stored therein.

*With respect to (c)*, Hunt '423 teaches the use of wood. *Accordingly*, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have fabricated the holder from wood for ease in economy and manufacture while allowing for increased structural stability.

*With respect to (d)*, although Szenay *et al.* '779 do not disclose the use of metal, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have fabricated the holder from metal for ease in economy and manufacture while allowing for increased structural stability.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szenay *et al.* '779 in view of Hunt '423 as applied to claims 7 and 10-12 above, and further in view of U.S. Patent No. 6,464,088 (Caplan *et al.* '088).

The claims differ from the references advanced above in requiring the holder to be motorized (claim 8) and to be remotely controlled (claim 9).

Caplan *et al.* '088 teach that it is old to have a rotating holder for media which comprises the use of a motor and a remote control.

*Accordingly*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the holder of Szenay *et al.* '779 with a motor and remote control for increased ease in use to the consumer.

#### ***Comments***

It is noted that the following recitations are functional recitations and structure and thus the cited art need not show these functional recitations and structure in order to meet the claim but rather the prior art need only be *capable* of performing the functions.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection. The new grounds of rejection were necessitated by the amendment reciting "a depth of approximately 3 ¾ inches" and "a depth of approximately 4 ½ inches" as in lines 8 and 14-15, respectively.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703)-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer E. Novosad/jen  
September 17, 2004



Carl D. Friedman  
Supervisory Patent Examiner  
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